TAB H

Serial No.   08/973,173   -2-
Tech. Center 2857

1.   This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order or the Examiner to consider the applicability of 35 U.S.C. 103(e) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> *A person shall be entitled to a patent unless —*
> *(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

3.   Claims 1-5, 10, 19, 20 and 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hecht *et al.* (5,032,979).

Hecht *et al.* discloses a plurality of use meters in client processors [222] and [333], loading logs of predetermined machine operations into computer memory, an audit program installed in a server [444] loading a log of predetermined machine operations in computer memory, the auditing program accessing, processing, and generating reports based on stored machine operations, each audit program being linked to the client processors.

More particularly with respect to claims 2 and 3, clearly the remote mount of Hecht *et al.* (see figure 2) comprises an electronic communication channel.

More particularly with respect to claim 4, said claim is directed towards establishing communication on a periodic basis. Hecht *et al.* discloses an auditing system which periodically initiates audits, creating a communication between the server and client.

As to claim 5, said claim is directed towards transferring data at periodic times based upon available memory. Hecht *et al.* discloses in column 11, starting in line 48 that managing of workstation audit files are dependent upon available storage space, "*If we have just a small work station with not much disk space ...it will fill up after a while and we have to manage it on a hourly or weekly basis.*"

JA00096

Serial No.   08/973,173   -3-
Tech. Center   2857

4.   Claims 1, 2, 10, 19, 20 and 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by Shear (4,827,508).

Shear discloses a plurality of use meters in client processors (see abstract), loading logs of predetermined machine operations into computer memory, an audit program installed in a server [416] loading a log of predetermined machine operations in computer memory, the auditing program accessing, processing, and generating reports based on stored machine operations, each audit program being linked to the client processors.

More particularly with respect to claim 2, clearly the remote mount of Shear [200] comprises an electronic communication channel.

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> *A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

6.   Claims 6-9 and 11-18 are rejected under 35 U.S.C. 103 as being unpatentable over Hecht *et al.*

As to claims 6 and 16, said claims are directed towards transferring auditing data via portable magnetic media. Because the device of Hecht *et al.* is directed to transfer of digital data, and because portable magnetic media is a known method of transferring digital data (i.e. manual data transfer, so-called "sneakernet"), it would have been obvious for one of ordinary skill in the art at the time the invention was made to substitute one known data transfer means for another, each performing similar functions in similar ways so as to receive the obvious benefits derived therefrom such as enhanced system flexibility.

Serial No.   08/973,173   -4-
Tech. Center   2857

More particularly with respect to claims 7, 8, 17, and 18, said claims are directed towards logging operation system call back messages and intercepted modem character string events. Such events are clearly within the definition of, "...*events which are relevant to the maintenance of the security of the system...*", as disclosed by Hecht *et al.* in the abstract.

More particularly with respect to claims 9 and 11, said claims are directed to the use of a dictionary file fr   ;eting logged events. Hecht *et al.* is directed towards the auditing of security logs. Th,   ' .ing of Hecht *et al.* clearly comprises a dictionary file, the Examiner notes the auditing of Hecht *et al.* comprising audit file filtering as disclosed in column 20 starting in line 40.

More particularly with respect to claim 12, said claim is directed towards the use of an electronic communication channel for data transfer. Clearly the network of Hecht *et al.* comprises an electronic channel.

More particularly with respect to claim 13, said claim is directed towards transferring log files based upon predetermined criteria. Hecht *et al.* discloses an auditing system which periodically initiates audits, creating a communication between the server and client. Clearly such periodic audits utilizing a network protocol constitutes such transference.

More particularly with respect to claim 14, said claim is directed towards establishing communication on a periodic basis. Hecht *et al.* discloses an auditing system which periodically initiates audits, creating a communication between the server and client.

As to claim 15, said claim is directed towards transferring data at periodic times based upon available memory. Hecht *et al.* discloses in column 11, starting in line 48 that managing of workstation audit files are dependent upon available storage space, "*If we have just a small work station with not much disk space ...it will fill up after a while and we have to manage it on a hourly or weekly basis.*"

JA00098

Serial No.   08/973,173   -5-
Tech. Center   2857

7.   Claims 21 and 23-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims or if said rejection(s) were overcome.

The Examiner notes that the prior art of record neither discloses nor fairly suggest any of; auditing a display wherein the application is an online service interface program and the active display elements titles are logged; auditing a display to extract edit box information utilizing a predetermined syntax, particularly a URL syntax; or, eavesdropping on operating system messages and indicating receipt of predetermined types of messages.

8.   Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Craig Steven Miller whose telephone number is (703) 305-9730. Art Unit facsimile services are now available at (703) 308-7722.
        The Examiner can normally be reached on Mondays-Friday from 07:15am-3:45pm EDT. Should repeated attempts to reach the Examiner be unsuccessful, the Examiner's Supervisor, Marc Hoff may be reached at (703) 308-1677.
        Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Craig Steven Miller (ss)
17 June 1999

Marc S. Hoff
Supervisory Primary Examiner

TAB I

GRPL-2857 #11/A
10-2-99
Roberto
Amdt

MMI 202 - NDH/RSMG

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Assistant Commissioner for Patents, Washington, D.C. 20231 on 9/22/99
Pani Kontopoulos

Lani Kontopordo   9/22/99
Signature   Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants   :   Steven R. COFFEY et al.

Serial No.   :   08/973,173

Filed   :   March 2, 1998

For   :   COMPUTER USE METER AND ANALYZER

Art Unit   :   2857

Examiner   :   C. Miller

Hon. Commissioner of Patents   September 22, 1999
  and Trademarks
Washington, D.C. 20231

RESPONSE UNDER 37 C.F.R. § 1.111

SIR:

This is in response to the Office Action of June 22, 1999.

IN THE CLAIMS

Please amend the claims as follows:

1.   (Amended) A computer use monitoring system comprising:

601151.1   1

MMI 202 - NDH/RSMG

a plurality of local computer use meters installed in user computer machines, each including a log of predetermined machine operation events stored in memory of said computer machines;

a processing station installed in a computer machine which loads a log of predetermined machine operation events into computer memory so as to log internet addresses of content and associated display titles;

a database management system installed in a computer machine configured to access, process and generate reports based on the machine operation events stored in said computer memory;

wherein said processing station is linked to said plurality of local computer use meters.

10.   (Amended) A computer use monitoring method comprising the steps of:

eavesdropping on operating system messages and indicating receipt of predetermined types of messages responsive to an operating system messaging module;

creating and storing an event log responsive to selected operating system messages in order to log internet addresses of content and associated display titles;

transferring one or more event logs from one or more computer systems to a central system; and

analyzing the contents of said event logs.

11.   (Amended) A method for determining the nature of computer use by a plurality of computer systems comprising the steps of:

generating a log of machine operation events in each of a plurality of user computer systems;

storing each of the events in said log in the local computer memory of said user computer systems so as to log internet addresses of content and associated display titles;

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transferring said stored events from said plurality of user computer systems to a processing station computer;

loading said event logs into memory associated with said processing station computer;

interpreting said event logs by reference to a dictionary stored in memory associated with said processing station computer; and

compiling and reporting said interpreted computer event logs according to specified criteria.

19.   (Amended) A computer use monitoring method comprising the steps of:

periodically auditing information displayed on a computer monitor <u>for information relating at least to the logging of internet addresses of content and associated display titles</u>; and

creating and storing a log of labels indicative of usage activity.

REMARKS

The Applicants thank the Examiner for including notations regarding the prior art of record in the present Office Action.

Independent claims 1, 10, 11, and 19 were amended so as to further define the present invention. Support for the new recitations within the amended claims may be found on page 3, line 13 to page 4, line 27 of the specification. As such, no new matter has been added.

Claims 1-5, 10, 19, 20, and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hecht et al; claims 1, 2, 10, 19, 20, and 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by Shear; and also, the Examiner has further rejected claims 1, 2, 3, 4, 5, 10, 19, 20, and 22 under 35 U.S.C. § 102 (b) as being anticipated by Hecht et al. and Shear.

Furthermore, claims 6-9 and 11-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hecht et al, while claims 21 and 23-25 are each objected to as being dependent upon a rejected base claim, but were deemed allowable if rewritten in independent

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form including all of the limitations of the base claim and any intervening claims or if said rejection(s) were overcome.

It is respectfully maintained that, with respect to Hecht et al. and Shear, whether cited alone or in combination, the presently claimed invention, unlike either cited teaching is directed (*inter alia*), to steps involving the logging of internet addresses of content and associated display titles. This is in direct contrast to both Hecht et al. and Shear, neither of which teaches or suggests the logging internet addresses and display titles. As such, it is believed that the presently rejected (and correspondingly objected) claims are now in place for allowance.
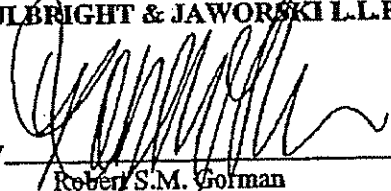
An early and favorable response is earnestly solicited.

Applicants believe that no fee is required for filing this amendment, however, should this not be the case the Commissioner is hereby authorized to deduct any fees associated with this filing from Deposit Account No. 500624.

Respectfully submitted,

FULBRIGHT & JAWORSKI L.L.P.

By _____
 / Robert S.M. Gofman
 Reg. No. 41,790

666 Fifth Avenue
New York, New York 10103
(212) 318-3000

TAB J

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/973,173	03/02/98	COFFEY	S	317.111

MM42/1203

ROBERT S M GORMAN
FULBRIGHT & JAWORSKI
666 FIFTH AVENUE
NEW YORK NY 10103

EXAMINER
MILLER, C

ART UNIT	PAPER NUMBER
2857	12

DATE MAILED: 12/03/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

FTO-90C (Rev. 2/95)

| **Office Action Summary** | Application No. 08/973,173 | Applicant(s) Coffey et al |
| | Examiner Craig Steven M. 16 | Group Art Unit 2857 |

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ___3___ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☑ Responsive to communication(s) filed on 27 September 1995

☑ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) _1-25_ is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) _1-20 and 22_ is/are rejected.

☑ Claim(s) _21 and 23-25_ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

☑ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☑ Notice of Reference(s) Cited, PTO-892

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other _____

Office Action Summary

Part of Paper No. _12_

Serial No.   08/973,173   -2-
Tech. Center   2857

1.   The text of those sections of Title 35, U.S. Code not included in this action can be found
in a prior Office action.

2.   Claims 1-19, 20 and 22 are rejected under 35 U.S.C. 103 as being unpatentable over Hecht
et al. (5,032,979) in view of Johnson et al. (5,878,384).

As to claims 6 and 16, said claims are directed towards transferring auditing data via
portable magnetic media. Because the device of Hecht et al. is directed to transfer of digital data,
and because portable magnetic media is a known method of transferring digital data (i.e. manual data
transfer, so-called "sneakernet"), it would have been obvious for one of ordinary skill in the art at the time
the invention was made to substitute one known data transfer means for another, each performing
similar functions in similar ways so as to receive the obvious benefits derived therefrom such as
enhanced system flexibility.

More particularly with respect to claims 7, 8, 17, and 18, said claims are directed towards
logging operation system call back messages and intercepted modem character string events.
Such events are clearly within the definition of, "...events which are relevant to the maintenance
of the security of the system...", as disclosed by Hecht et al. in the abstract.

More particularly with respect to claim 9, said claim is directed to the use of a dictionary
file for interpreting logged events. Hecht et al. is directed towards the auditing of security logs.
The auditing of Hecht et al. clearly comprises a dictionary file, the Examiner notes the auditing
of Hecht et al. comprising audit file filtering as disclosed in column 20 starting in line 40.

With respect to claim 11, said claim is directed to the use of a dictionary file for
interpreting logged events. Hecht et al. is directed towards the auditing of security logs. Hecht et
al. discloses the instant invention as claimed with the exception that Hecht et al. does not specify
that internet URLs should be monitored. The auditing of Hecht et al. clearly comprises a
dictionary file, the Examiner notes the auditing of Hecht et al. comprising audit file filtering as
disclosed in column 20 starting in line 40. Johnson et al. discloses in col. 6 starting in line 19
that, "...the URL information is captured as a string of ASCII text." Because the devices of
Hecht et al. and Johnson et al. are both within the art of monitoring computer use and because

Serial No.   08/973,173   -3-
Tech. Center 2857

Johnson *et al.* discloses that such URL information should be monitored, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include within the device of Hecht *et al.* the monitoring of internet URL so as to receive the obvious benefits derived therefrom such as monitoring the well known use of computers on the internet.

More particularly with respect to claim 12, said claim is directed towards the use of an electronic communication channel for data transfer. Clearly the network of Hecht *et al.* comprises an electronic channel.

More particularly with respect to claim 13, said claim is directed towards transferring log files based upon predetermined criteria. Hecht *et al.* discloses an auditing system which periodically initiates audits, creating a communication between the server and client. Clearly such periodic audits utilizing a network protocol constitutes such transference.

More particularly with respect to claim 14, said claim is directed towards establishing communication on a periodic basis. Hecht *et al.* discloses an auditing system which periodically initiates audits, creating a communication between the server and client.

As to claim 15, said claim is directed towards transferring data at periodic times based upon available memory. Hecht *et al.* discloses in column 11, starting in line 48 that managing of workstation audit files are dependent upon available storage space, *"If we have just a small work station with not much disk space ...it will fill up after a while and we have to manage it on a hourly or weekly basis."*

As to claims 1, 10, 19, 20 and 22, Hecht *et al.* discloses the instant invention as claimed with the exception that Hecht *et al.* does not specify that a internet URLs should be logged. Hecht *et al.* discloses a plurality of use meters in client processors [222] and [333], loading logs of predetermined machine operations into computer memory, an audit program installed in a server [444] loading a log of predetermined machine operations in computer memory, the auditing program accessing, processing, and generating reports based on stored machine operations, each audit program being linked to the client processors. Johnson *et al.* discloses in col. 6 starting in line 19 that, *"...the URL information is captured as a string of ASCII text."* Because the devices of Hecht *et al.* and Johnson *et al.* are both within the art of monitoring computer use and because

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Serial No.   08/973,173   -4-
Tech. Center 2857

Johnson *et al.* discloses that such URL information should be monitored, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include within the device of Hecht *et al.* the monitoring of internet URL so as to receive the obvious benefits derived therefrom such as monitoring the well known use of computers on the internet.

More particularly with respect to claims 2 and 3, clearly the remote mount of Hecht *et al.* (see figure 2) comprises an electronic communication channel.

More particularly with respect to claim 4, said claim is directed towards establishing communication on a periodic basis. Hecht *et al.* discloses an auditing system which periodically initiates audits, creating a communication between the server and client.

As to claim 5, said claim is directed towards transferring data at periodic times based upon available memory. Hecht *et al.* discloses in column 11, starting in line 48 that managing of workstation audit files are dependent upon available storage space, "*If we have just a small work station with not much disk space ...it will fill up after a while and we have to manage it on a hourly or weekly basis.*"

3.   Claims 1, 2, 10, 19, 20 and 22 are rejected under 35 U.S.C. 103 as being unpatentable over Shear (4,827,508) in view of Johnson *et al.*

Shear discloses the instant invention as claimed with the exception that Shear does not specify that internet URLs should be monitored. Shear discloses a plurality of use meters in client processors (see abstract), loading logs of predetermined machine operations into computer memory, an audit program installed in a server [416] loading a log of predetermined machine operations in computer memory, the auditing program accessing, processing, and generating reports based on stored machine operations, each audit program being linked to the client processors. Johnson *et al.* discloses in col. 6 starting in line 19 that, "*...the URL information is captured as a string of ASCII text.*" Because the devices of Shear and Johnson *et al.* are both within the art of monitoring computer use and because Johnson *et al.* discloses that such URL information should be monitored, it would have been obvious to one of ordinary skill in the art at

JA00108

Serial No.   08/973,173   -5-
Tech. Center   2857

the time the invention was made to include within the device of Shear the monitoring of internet URL so as to receive the obvious benefits derived therefrom such as monitoring the well known use of computers on the internet.

More particularly with respect to claim 2, clearly the remote mount of Shear [200] comprises an electronic communication channel.

4.   Claims 21 and 23-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims or if said rejection(s) were overcome.

The Examiner notes that the prior art of record neither discloses nor fairly suggest any of; auditing a display wherein the application is an online service interface program and the active display elements titles are logged; auditing a display to extract edit box information utilizing a predetermined syntax, particularly a URL syntax; or, eavesdropping on operating *system* messages and indicating receipt of predetermined types of messages.

5.   Applicant's arguments have been considered but are moot in view of the new grounds of rejection.

6.   Applicant's amendment necessitated the new ground(s) of rejection presented in the Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
    A *shortened statutory period for response* to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

JA00109

Serial No.   08/973,173   -6-
Tech. Center 2857

7.   Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Craig Steven Miller whose telephone number is (703) 305-9730. Art Unit facsimile services are now available at (703) 308-7722.

      The Examiner can normally be reached on Mondays-Friday from 07:15am-3:45pm EDT. Should repeated attempts to reach the Examiner be unsuccessful, the Examiner's Supervisor, Marc Hoff may be reached at (703) 308-1677.

      Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Craig Steven Miller (ss)
01 December 1999

                                        MARC S. HOFF
                                 SUPERVISORY PATENT EXAMINER
                                   TECHNOLOGY CENTER 2800

Notice of References Cited

Application No.	Applicant(s)
08/973,173	Coffey et al.

Examiner	Group Art Unit	Page 1 of 1
Craig Steven Miller	2857	

U.S. PATENT DOCUMENTS

*	DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS
A	5,878,384	3/99	Johnson et al.	702	187
B					
C					
D					
E					
F					
G					
H					
I					
J					
K					
L					
M					

FOREIGN PATENT DOCUMENTS

*	DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUBCLASS
N						
O						
P						
Q						
R						
S						
T						

NON-PATENT DOCUMENTS

*	DOCUMENT (Including Author, Title, Source, and Pertinent Pages)	DATE
U		
V		
W		
X		

NR-CORE001039

JA00111

TAB K

JAN 14 2000 10:51 FR FULBRIGHT&JAWORSKI 24   TO 01933⬛702805170 P.07/22

MMI 202.1 - FEE/CAP

FAX COPY RECEIVED

JAN 1 4 2000

TECHNOLOGY CENTER 2800

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	Steven R. COFFEY et al.
Serial No.	:	CPA of 08/973,173
Filed	:	Herewith
For	:	COMPUTER USE METER AND ANALYZER
Art Unit	:	2857
Examiner	:	C. Miller

January 14, 2000

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

PRELIMINARY AMENDMENT

SIR:

Before the issuance of the first Office Action in this continued prosecution application (CPA), and responsive to the Office Action dated December 3, 1999, which issued with respect to the parent of this continuation, please amend the above-identified continuation as follows:

625592.1

JAN 14 2000 10:51 FR FULBRIGHT&JAWORSKI 24   TO 01933097802005170 P.08/22

IN THE SPECIFICATION:

Page 1, prior to line 1, add

--Related Application

This application is a ~~continuation of pending U.S. patent application Serial No.~~

~~08/973,173, which was the~~ National Stage of International Application No. PCT/US96/10091,

filed June 7, 1996, which ~~claims benefit of priority from~~ *is a continuation of* U.S. patent application Serial No.

08/474,082, filed June 7, 1995, now U.S. Patent No. 5,675,510, and are incorporated by

reference in their entirety.--

IN THE CLAIMS:

Please cancel claims 1-25 without prejudice and add the following new claims:

--26.   A monitoring system, comprising:

a plurality of local computer use meters installed in user computer machines, each user

meter including a log of predetermined events stored in an associated user computer machine,

wherein said log of predetermined events identifies character strings reflecting on-line activity;

a central processing station which receives and stores said log of predetermined events

from said plurality of computer use meters;

a database management system for accessing, processing and generating reports based on

the stored predetermined events; and

wherein said processing station is linked to said plurality of computer use meters.--

27.   The monitoring system of claim 26, wherein said character strings represents a URL

625592.1   -2-

NR-CORE001056

JA00113

address on the world wide web.—

4

-28.   The monitoring system of claim 26, wherein said central processing station receives said

log of predetermined events over an electronic communication channel.—

5

-29.   The monitoring system of claim 26, wherein said each user meter logs applications

running on said associated user computer machine.—

6

-30.   The monitoring system of claim 29, wherein said each user meter logs the launching and

termination of application on said associated user computer machine.—

7

-31.   The monitoring system of claim 30, wherein said each user meter logs the switching

resources from one application to another, the minimizing an application and the restoring an

application on said associated user computer machine.—

3

-32.   The monitoring system of claim 27, wherein said each user meter logs at least date and

time information with each predetermined events stored in said associated user computer

machine to provide web traffic statistical information.—

8

-33.   The monitoring system of claim 26, wherein said each user meter includes a timer to

periodically audit information displayed on said associated user computer machine.—

625592.1   -3-

9

~34. The monitoring system of claim 26, wherein said each user meter includes a timer to periodically audit information requested by said associated user computer machine.—

10

~35. The monitoring system of claim 26, wherein said each user meter compresses said log of predetermined events and stores said compressed log of predetermined events in said associated user machine.—

11

~36. The monitoring system of claim 26, wherein said each user meter encrypts said log of predetermined events and wherein said central processing station receives said encrypted log of predetermined events from said plurality of computer use meters—

12

~37. A monitoring method, comprising the steps of:

logging predetermined events by a plurality of local computer use meters installed in user computer machines, wherein said log of predetermined events identifies character strings reflecting on-line activity;

storing said log of predetermined events by each use meter in an associated user computer machine;

receiving and storing said log of predetermined events by a central processing station from said plurality of computer use meters;

accessing, processing and generating reports based on the stored predetermined events by a database management system; and

wherein said processing station is linked to said plurality of computer use meters.—

625592.1   -4-

NR-CORE001058

JA00115

38. The monitoring method of claim 37, wherein said character strings represents a URL address on the world wide web.--

39. The monitoring method of claim 37, wherein the step of receiving and storing receives said log of predetermined events over an electronic communication channel.--

40. The monitoring method of claim 37, wherein the step of logging logs applications running on said associated user computer machine.--

41. The monitoring method of claim 40, wherein the step of logging logs the launching and termination of application on said associated user computer machine.--

42. The monitoring method of claim 41, wherein the step of logging logs the switching resources from one application to another, the minimizing an application and the restoring an application on said associated user computer machine.--

43. The monitoring method of claim 38, wherein the step of logging logs at least date and time information with each predetermined events stored in said associated user computer machine to provide web traffic statistical information.--

44. The monitoring method of claim 37, further comprising the step of periodically auditing

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JA00116

information displayed on said associated user computer machine.--

25.   The monitoring method of claim 37, further comprising the step of periodically auditing information requested by said associated user computer machine.--

46.   The monitoring method of claim 37, wherein the step of logging includes the step of compressing said log of predetermined events; and wherein the step of storing stores said compressed log of predetermined events in said associated user machine.--

47.   The monitoring method of claim 37, wherein the step of logging includes the step of encrypting said log of predetermined events.--

48.   The monitoring method of claim 37, further comprising the step of eavesdropping on operating system messages and indicating the receipt of predetermined types of messages responsive to an operating system module.--

REMARKS

In parent application Serial No. 973,173, filed March 2, 1998, an Office Action dated December 3, 1999 issued and the following remarks are provided in response to that Office Action.

Claims 1-25 have been canceled and new claims 26-48 have been added. Accordingly,

claims 26-48 are presented for consideration.

In light of the above amendments and remarks to follow, reconsideration and allowance of this application are requested.

Applicants' undersigned attorneys appreciate the opportunity afforded by the Examiner to discuss the parent case and his kind offer to expedite the processing and handling of this continuation application by the Examiner.

Claims 1-20 and 22 have been rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent 5,032,979 (Hecht et al.) in view of U.S. Patent 5,878,384 (Johnson et al.) and claims 1,2, 10, 19, 20 and 22 also have been rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent 4,827,508 (Shear) in view of Johnson et al. To expedite the prosecution of this application, claims 1-25 have been rewritten as new claims 26-48, and this rejection will be construed as if it applies to new claims 26-48.

The present application is entitled to a priority filing date of June 7, 1995, the date on which the parent application Serial No. 08/474,082, now U.S. Patent 5,675,510 (Coffey et al.), was filed, in accordance with the provisions of 35 U.S.C. §1.119. It is noted that the Johnson et al. patent, relied upon by the Examiner in rejecting claims 1-20 and 22 is entitled to a U.S. filing date of March 29, 1996. Thus, the effective filing date of the instant application antedates the March 29, 1996 filing date of the Johnson et al. patent. In view of the earlier effective filing date

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of the present application, the Johnson et al. reference is not available as prior art against the rejected claims hereof, all of which find support in applicants' parent case. (This is detailed infra.) It is therefore requested that this reference be removed and that claims 26-48 be allowed.

However, applicants do not admit either expressly or impliedly, that the disclosure of Johnson et al. anticipates or renders obvious applicant's claimed invention.

Claim 1 has been canceled and is replaced by new claim 26 which identifies the log of predetermined events as "character strings reflecting on-line activity". Support for the recitations of claim 26 is set forth from page 3, line 24 to page 4, line 4, and page 7, line 16 to page 8, line 10 of the specification (or Coffey et al., column 2, lines 34-49; column 4, lines 20-51). Accordingly, it is respectfully submitted that claim 26 is patentably distinct over Hecht et al. and Shear for the reasons given in the Amendment filed on September 27, 1999.

New claim 27 depends from claim 26 and additionally states that the character string represents a URL address on the world wide web. Support for the recitations of claim 27 is set forth at page 3, lines 27-33 of the specification (or Coffey et al., column 2, lines 38-45). The allowance of claim 27 is solicited for the reasons given above with respect to claim 26.

New claim 28 depends from claim 26 and recites substantially same subject matter as original claim 2, now canceled. The allowance of claim 28 is solicited for reasons given above with respect to claim 26.

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JA00119

New claim 29 depends from claim 26 and additionally states that each use meter logs applications running on the user computer machine. Support for the recitations of claim 29 is set forth at page 2, lines 18-24; page 12, lines 19-28; page 13, line 13-26 of the specification (or Coffey et al., column 1, lines 57-64; column 7, lines 13-23; column 8, lines 16-29). The allowance of claim 29 is solicited for the reasons given above with respect to claim 26.

New claim 30 depends from claim 29 and additionally states that each use meter logs the launching and termination of application on the user computer machine. Support for the recitations of claim 30 is set forth at page 2, lines 20-22; page 11, line 18 to page 12, line 1; page 12, lines 12-19; page 13, line 13-26 of the specification (or Coffey et al., column 1, lines 60-61; column 6, lines 39-58; column 7, lines 5-13; column 8, line 16-29). The allowance of claim 30 is solicited for the reasons given above with respect to claim 29.

New claim 31 depends from claim 30 and additionally states that each use meter logs the switching resources from one applications to another, the minimizing an application and the restoring an application on the user computer machine. Support for the recitations of claim 31 is set forth at page 2, lines 22-24; page 12, lines 1-11; page 13, line 13-26 of the specification (or Coffey et al., column 1, lines 61-63; column 6, line 58 to column 7, line 4; column 8, line 16-29). The allowance of claim 31 is solicited for the reasons given above with respect to claim 30.

New claim 32 depends from claim 30 and additionally states that each use meter logs date and time information with each predetermined events. Support for the recitations of claim 32 is

set forth from page 2, line 27 to page 3, line 4; page 3, lines 19-23; page 3, line 33 to page 4, line 4; page 14, line 1 to page 16, line 9 of the specification (or Coffey et al., column 2, lines 1-11, lines 28-33 and lines 45-50; table in columns 7-10). The allowance of claim 32 is solicited for the reasons given above with respect to claim 30.

New claim 33 depends from claim 26 and partially recites substantially same subject matter as conditionally allowed claim 21, now canceled. Particularly, claim 33 states that each use meter includes a timer to periodically audit information displayed on the user machine. The allowance of claim 33 is solicited for the reasons given above with respect to claim 26 and for the same reasons as canceled claim 21.

New claim 34 depends from claim 26 and partially recites substantially same subject matter as conditionally allowed claim 21, now canceled. Particularly, claim 34 states that each use meter includes a timer to periodically audit information requested by the user machine. The allowance of claim 34 is solicited for the reasons given above with respect to claim 26 and for the same reasons as canceled claim 21.

New claim 35 depends from claim 26 and additionally states that each use meter compresses the log of predetermined events. Support for the recitations of claim 35 is set forth at page 5, lines 1-4; page 8, lines 15-16 of the specification (or Coffey et al., column 2, lines 57-61; column 4, lines 57-59). The allowance of claim 35 is solicited for the reasons given above with respect to claim 26.

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New claim 36 depends from claim 26 and additionally states that each use meter *encrypts the log of predetermined events.* Support for the recitations of claim 36 is set forth at page5, lines 1-4 of the specification (or Coffey et al., column 2, lines 57-61). The allowance of claim 36 is solicited for the reasons given above with respect to claim 26.

New claim 37 is a method claim and recites the steps of performing those function which are carried out by means of system claim 26. The allowance of claim 37 is solicited for the reasons given above with respect to claim 26.

New claim 38 is a method claim and recites the steps of performing those function which are carried out by means of system claim 27. The allowance of claim 38 is solicited for the reasons given above with respect to claim 27.

New claim 39 is a method claim and recites the steps of performing those function which are carried out by means of system claim 28. The allowance of claim 39 is solicited for the reasons given above with respect to claim 28.

New claim 40 is a method claim and recites the steps of performing those function which are carried out by means of system claim 29. The allowance of claim 40 is solicited for the reasons given above with respect to claim 29.

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New claim 41 is a method claim and recites the steps of performing those function which are carried out by means of system claim 30. The allowance of claim 41 is solicited for the reasons given above with respect to claim 30.

New claim 42 is a method claim and recites the steps of performing those function which are carried out by means of system claim 31. The allowance of claim 42 is solicited for the reasons given above with respect to claim 31.

New claim 43 is a method claim and recites the steps of performing those function which are carried out by means of system claim 32. The allowance of claim 43 is solicited for the reasons given above with respect to claim 32.

New claim 44 is a method claim and recites the steps of performing those function which are carried out by means of system claim 33. The allowance of claim 44 is solicited for the reasons given above with respect to claim 33.

New claim 45 is a method claim and recites the steps of performing those function which are carried out by means of system claim 34. The allowance of claim 45 is solicited for the reasons given above with respect to claim 34.

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New claim 46 is a method claim and recites the steps of performing those function which are carried out by means of system claim 35. The allowance of claim 46 is solicited for the reasons given above with respect to claim 35.

New claim 47 is a method claim and recites the steps of performing those function which are carried out by means of system claim 36. The allowance of claim 47 is solicited for the reasons given above with respect to claim 36.

New claim 48 depends from claim 37 and additionally includes the step of eavesdropping on operating system messages. Support for the recitations of claim 48 is set forth at page 2, lines 13-17 of the specification (or Coffey et al., column 1, lines 51-57)

Statements appearing above in respect to the disclosures in the cited references represent the present opinion of the applicants' undersigned attorney and, in the event that the Examiner disagrees with any such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the reference providing the basis for a contrary view.

Applicants' representative agrees with the Examiner's implicit finding that the prior art made of record and not relied upon is not as relevant to the claimed invention as Hecht et al. and Shear.

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NR-CORE001067

JA00124
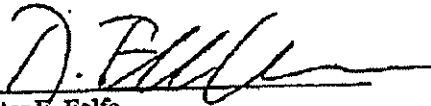
JAN 14 2000 10:55 FR FULBRIGHT&JAWORSKI 24   TO 01933097028051.70 P.20/22

On the basis of the above amendments and remarks, reconsideration and allowance of

claims 26-48 are respectfully requested.

Respectfully submitted,

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TAB L

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

----------------------ooo:O:ooo----------------------

Application of	:	
Owen Davis et al.	:	Group Art Unit: 2317
Serial No. 08/821,534	:	
Filed: March 21, 1997	:	
For: METHOD AND APPARATUS	:	
FOR TRACKING CLIENT	:	
INTERACTION WITH A	:	
NETWORK RESOURCE AND	:	
CREATING CLIENT PROFILES	:	
AND RESOURCE DATABASE	:	Docket No. D004-3169

----------------------ooo:O:ooo----------------------

COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C.   20231

ATTORNEY'S STATEMENT IN SUPPORT OF
PETITION TO MAKE SPECIAL UNDER 37 CFR §1.102(d)

S I R:

Pursuant to 37 CFR §1.102 and MPEP §708.02 II and
VIII (c), (d) and (e), applicant's undersigned counsel hereby
states that the present petition to make special is based upon
the existence of actual infringing sales and that a pre-
examination search was performed with respect to the subject
matter of the captioned patent application and invention in
the records of the U.S. Patent and Trademark Office.

The field of the novelty search was conducted in U.S. Class 364, subclasses 222, 460, 464.28, 475.9, 481, 550, 569 and 570; Class 380, subclass 4; and Class 395, subclasses 200.54, 280, 381, 680 and 712. A search was also conducted on the LEXIS/NEXIS database to uncover all prior art patents in the field of computer software relating to the tracking or monitoring of the amount of time a resource is displayed or interacted with.

Submitted herewith are copies of the most pertinent references uncovered during the search together with a List of Prior Art Cited by Applicant (PTO 1449) listing each reference. A summary of the references is provided immediately hereinafter, followed by a discussion of the claimed invention at pages 9-13 and a description of the infringing sales at pages 13-15.

U.S. Patent No. 5,675,510 to Coffey et al. ("Coffey"), entitled "Computer Use Meter and Analyzer," discloses a system and method for measuring and reporting on the use of a personal computer by use of an executable tracking program resident on the personal computer which creates a log file. The log file includes entries corresponding to predetermined events, such as keyboard or mouse events. The executable program reports on the application software and hardware used and computer functions

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JA00127

engaged by the user by transmitting the log file to a remote
processor via a telephone line. The log files from one or
more computers may be assembled and analyzed to ascertain
computer use habits for computer software, computer hardware
and computer communications. The system may also be used to
predict computer use trends and to represent computer use
history of selected users. While Coffey discloses a tracking
program for monitoring client interaction with various
resources, it fails to disclose or suggest a method of
monitoring client interaction with a resource downloaded from
a server in which an executable tracking program is downloaded
from a server to the client to monitor client interaction with
the resource. In Coffey, the tracking program is permanently
resident on personal computers belonging only to a selected
panel of users representative of a population. Using the
Coffee tracking program, computer use trends for the entire
population are extrapolated based upon use habits of the
members of the panel. Much like the well known Nielsen rating
system used in television broadcasting, the Coffey system uses
a program loaded only on selected computers and monitors and
tracks usage of only those computers. Unlike the Coffee
system, the claimed invention may be used without any similar
limitations since it permits the address of an executable
program to be embedded in a resource that may be downloaded to
any personal computer.

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U.S. Patent No. 5,682,525 to Bouve et al. ("Bouve"),
entitled "System and Methods For Remotely Accessing a Selected
Group of Items of Interest From a Database," discloses a
method and apparatus which allows a user to access a common
database from a remote communications port, at any qualified
location, to generate a map or other positional information
which locates selected items of interest. In a preferred
embodiment, the database architecture includes separate phone
and fax interfaces to interface with any of a plurality of
remote ports. A database storage memory stores information
which is accessible by the end user and which is responsive to
user requests, including the storage of selected cities,
locations of interest, maps of geographic vicinities, and
advertising information. An additional information storage
memory stores information which is accessible by the system
data server and which stores information such as system usage
and transaction logging. While Bouve discloses a method for
monitoring the amount of time a user spends interacting with
and displaying a file downloaded from a remote server, it
requires continuity of direct connection between a user device
and database server in order for the server to monitor the
time a user interacts with the database. Bouve does not
disclose or suggest a method of monitoring client interaction
with a resource downloaded from a server in which an

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executable tracking program is downloaded from a server to the client to monitor client interaction with the resource.

U.S. Patent No. 4,977,594 to Shear ("Shear"), entitled "Database Usage Metering and Protection System and Method," discloses a system for metering and billing the usage of information distributed on a CD-ROM. The system requires the addition of an executable billing software module to a client computer system. The billing module may operate in a number of different ways. First, it may periodically communicate billing data to a central billing facility via a telephone line, whereupon the user may be billed. Second, billing may occur by disconnecting the billing module and sending it to a central billing facility where the data is read and a user bill generated. While Shear enables a server or software producer to monitor access and usage of a resource by a client, it does not disclose or suggest a method of monitoring client interaction with a resource downloaded from a server in which an executable tracking program is downloaded from a server to the client to monitor client interaction with the resource.

U.S. Patent No. 5,638,443 to Stefik et al. ("Stefik"), entitled "System for Controlling the Distribution and Use of Composite Digital Works," discloses a system for monitoring and controlling access to publications (digital

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JA00130

works) available on-line. Each digital work is comprised of a

description part and a content part. The description part

contains control information for the composite digital work.

The content part stores the actual digital data comprising the

composite digital work. The description part is logically

organized in an acyclic structure (e.g. a tree structure).

For a composite digital work, each node of the acyclic

structure represents an individual digital work or some

distribution interest in the overall composite work. Each

node in the acyclic structure is comprised of an identifier of

the corresponding individual work, usage rights for the

individual digital work and a pointer to the digital work.

The description part may be stored in a separate location from

the content part. Composite digital works are stored in

repositories comprising a storage means for storing a digital

work and its attached usage rights, an external interface for

receiving and transmitting data, a processor and a clock.

Although Stefik discloses a system for monitoring access and

usage of resources downloaded from a remote server, the

reference fails to disclose or suggest a method of monitoring

client interaction with a resource downloaded from a server in

which an executable tracking program is downloaded from a

server to the client to monitor client interaction with the

resource.

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JA00131

In addition to the foregoing U.S. Patents, the following publications have been uncovered by the prior art search.

S. Gundavaram, CGI Programming on the World Wide Web (O'Reilley & Assoc., Inc.), pgs. 202-204, discloses the acquisition of client identifying indicia by the use of "persistent cookies." As disclosed by CGI Programming, one feature of the Netscape Navigator is the ability to store information on the client side. It does this by accepting a new Set-Cookie header from CGI programs, and passing that information back using a HTTP_COOKIE environment variable. The Set-Cookie header sets one cookie on the client side, where a key is equal to a value. When a certain document is accessed by the user, the browser will send the cookie information, provided that it is valid to do so, as the environment variable HTTP_COOKIE. Thus, the "cookie" of a client may be set by a server and later acquired by the server when the client passes a TCP/IP request to the server for a particular resource.

G. Cornell and S. Horstmann, Core Java (The Sunsoft Press), pgs. 562-579, discloses the generation of executable "order forms" on a client computer. In this application, the client machine loads a Web page from a server which has an embedded link to an executable program that downloads to and

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JA00132

executes on the client machine. Upon execution in the client
machine, the program contacts the server and retrieves a list
of goods and associated prices. The program allows the user
to order various goods and requires the user to fill out a
form for billing purposes. The user "clicks" on the submit
button of the fill-in form to transmit the information to the
server. This method of user-specific data acquisition
requires the active participation of the user, and does not
provide for the automatic determination of user preferences
and interests.

In summary, while the prior art uncovered by the
novelty search is pertinent in disclosing and teaching various
elements of the present invention, such as the prior art
existence of methods for monitoring client interaction with a
resource downloaded from a server, the use of the Java
programming language for downloading executable programs to
client machines, and the acquisition of client identifying
indicia, various claimed features of the present invention are
patentably distinct from the prior art. For instance, none of
the references uncovered by the novelty search disclose or
suggest a method of monitoring client interaction with a
resource downloaded from a server in which an executable
tracking program is embedded in the resource and downloaded
from a server to a client to monitor client interaction with

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JA00133

the resource, as required by claim 1 of the captioned patent application.

More specifically, claim 1 of the captioned patent application recites a method of monitoring the amount of time a user interacts with and displays a file downloaded from a server, comprising the steps of:

(1) using a client to specify an address of a resource located on a first server;

(2) downloading a file corresponding to the resource from the first server in response to specification of the address;

(3) using the client to specify an address of a first executable program located on a second server, the address of the first executable program being embedded in the file downloaded from the first server, the first executable program including a software timer for monitoring the amount of time the client spends interacting with and displaying the file downloaded from the first server;

(4) downloading the first executable program from the second server to run on the client so as to determine the amount of time the client interacts with the file downloaded from the first server;

(5) using a server to acquire client identifying indicia from the client; and

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(6) uploading the amount of time determined by the
first executable program to a third server.

Accordingly, the invention recited in claim 1
requires that the client specify an address of an executable
program used for monitoring the amount of time a client spends
interacting with and displaying a file downloaded from a
server, wherein the address is embedded in the downloaded
file.

None of the references uncovered by the novelty
search discloses the combination of elements recited in claim
1 of the captioned application. Moreover, independent claims
35, 69 and 71 of the application have similar limitations,
which are neither disclosed nor suggested by any of the
foregoing references, either alone or in combination.

In one embodiment of the claimed invention, the URL
(i.e., the address) of a tracking program is embedded in a
resource, such as a Web page formatted in the Hypertext Markup
Language ("HTML") which is sent from a server to a client
based upon a TCP/IP request. The tracking program may
originate on a different server than the resource, in which
case it may be obtained by the client through a TCP/IP request
to the other server. The tracking program executes on a
client machine, and is stored in RAM. The tracking program
may monitor various indicia, such as time, mouse events,

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JA00135

keyboard events, and the like, in order to track a user's
interaction with the Web page. Thus, the tracking program may
simply monitor the amount of time the user spends interacting
(or viewing) the Web page, or may monitor details of choices
(such as links) made by individual users within a particular
Web page.

In general, a Web browser running on the client
machine uses a TCP/IP connection to pass a request to a Web
server running an HTTP service. The HTTP service then
responds to the request, typically by sending a Web page to
the browser. The browser displays the Web page. After any
required initialization is performed, the tracking program is
executed and may monitor the length of time the user remains
in the Web page, or any one or more portions thereof, and may
track some or all mouse and keyboard events to provide
meaningful data to the Web server concerning the user's
interaction with the Web page.

In its simplest form, the tracking program is a
timer program linked to an HTML document and is downloaded and
executed on a client when the HTML document is served to the
client in response to a client TCP/IP request. During or
after the client formats and displays the Web page specified
by the HTML document, the tracking program begins a software
timer to monitor the amount of time the Web page is displayed

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on the client computer. When the user leaves the Web page by
exiting the Web page or "clicking" on a link to another
resource, the tracking program sends the monitored time to
another computer on the Internet for storage and analysis.
Other available client information, such as the network ID and
the client ID, or so-called "cookie" of the client, is also
acquired and sent to the server for use by the administrator
of the server or network to monitor how long clients are
interacting with the server's resources.

In order to store client-identifying indicia, such
as a user's network ID (IP) and client ID numbers (Cookies)
and associated tracking information, a database is set up on a
server. In the case of the tracking program described above,
the information stored in the server database may include the
network ID, client ID, the associated link (the URL of the Web
page), the amount of time the user spent interacting with the
Web page, and any selections or choices made by the user while
interacting with the Web page.

In the embodiment illustrated in Figure 5 of the
application drawings, a software timer is initiated or stopped
when the user causes a predetermined keyboard or mouse event
to occur by clicking on a specified area of a part of a Web
page (such as an advertising banner). Rather than monitoring
the amount of time the user spends viewing the entire Web

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page, the tracking program monitors the amount of time a user
spends interacting with or viewing a portion of the Web page,
such as a particular advertising banner. For example, if the
Web page is provided with an advertising banner that includes
a link to the advertiser's Web site, the tracking program can
be adapted to monitor the amount of time the user views a Web
page of that site. Alternatively, if the advertising banner
is provided with an interactive resource such as a game or
information resource activated by clicking on a particular
button, the tracking program may determine how long a user has
interacted with that resource.

Attached as Exhibits A through C are Web site
advertisements published by three of applicants' competitors.
Each of these competitors is presently offering for sale
Internet advertising services and/or products that directly
and literally infringe numerous claims of the present patent
application. Exhibits A and B each show an offer for sale of
an advertising service which provides Internet advertisers
with detailed information concerning client interaction with
ad banners, including the amount of time users interact with
and display such banners. In the context of an ad banner,
this is accomplished by downloading an ad banner in the form
of an HTML formatted document which includes a link (URL) to
an executable program (JAVA applet) that is also downloaded to

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the client computer and which executes in the client computer
to track client interaction with the ad banner, including the
amount of time the client spends interacting with the ad
banner, and to acquire client identifying indicia. The
executable program then transmits the tracked information and
client identifying indicia to a server, where it can be
maintained and analyzed. Such a process directly and
literally infringes numerous claims of the captioned patent
application, including independent claims 1, 35, 69 and 71.

Exhibit C shows a software package being offered for
sale to Internet advertising services that uses JAVA programs
to carry out the claimed method. As disclosed by Exhibit C, a
JAVA applet, named "client", is downloaded to a client
computer for monitoring client interaction with resources,
such as advertisements, downloaded from the Internet.

Petitioners' undersigned counsel hereby states that
a rigid comparison of the infringing methods shown in Exhibits
A and B and the product shown in Exhibit C with the claims of
the application has been made and that in his opinion, at
least some of the claims are unquestionably infringed. As
noted above, the undersigned counsel has also caused a careful
and thorough search of the prior art to be made to uncover
references disclosing the use of tracking programs used to
monitor client interaction with network resources, including

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access time. No such reference discloses or suggests the novel aspects of the invention recited in independent claims 1, 35, 69 and 71.

Respectfully submitted,

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-15-

TAB M

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

8-T

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.
09/707,279	09/03/98	BLUMENAU	T	

LMC1/0303

DAVID R GRAHAM
1337 CHEWPON AVENUE
MILPITAS CA 95035

EXAMINER
NGUYEN,

ART UNIT	PAPER NUMBER
2764	8

DATE MAILED: 03/03/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95)   1- File Copy

JA00141

Office Action Summary	Application No. 08/707,279	Applicant(s) BLUMENAU
	Examiner Cuong H. Nguyen	Group Art Unit 2764

☒ Responsive to communication(s) filed on _5/14/98 (the IDS)._

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire ____3____ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) _1-66_____ is/are pending in the application.

    Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) _1-66_____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on ___Sep 3, 1996___ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

    ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

        ☐ received.

        ☐ received in Application No. (Series Code/Serial Number) _____ .

        ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

    *Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _2, 6_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

U.S. Patent and Trademark Office
PTO-326 (Rev. 9-95)   Office Action Summary   Part of Paper No. __8__

JA00142

Serial Number: 08/707,279
Art Unit: 2764

DETAILED ACTION

1.   This Office Action is the answer to the communication received
on 10/19/98.

2.   Claims 1-66 are pending in this application.

Drawing Objections

3.   The drawings submitted with this application were declared
informal by the applicants, the drawings are acceptable for
examination purposes only. Accordingly, they have not been
reviewed by a draftsperson at this time. When formal drawings are
submitted, the draftsperson will perform a review.

The examiner submits that "a system for monitoring displays by
a computer system and its associated network" should be included in
drawings.

Direct any inquiries concerning drawing review to the Drawing
Review Branch (703) 305-8404.

Specification Objection

4.   The disclosure is objected to because of the following
informality:

The title of the invention is not descriptive. A new title is
required that is clearly indicative of the invention to which the
claims are directed.

The following title is suggested: "Content display monitoring
by a computer system".

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Appropriate correction is required.

The following rejections are based on the examiner's best interpretation of the claims.

Claim Objection

5.   Claims 8 is objected as being incomplete for omitting essential element, such omission amounting to a gap between the elements. The omitted element is: a typo error (missing word) on line 4 of claim 8.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for indefiniteness "...means for monitoring the change in time of a characteristic of the content display...". This characteristic should be defined (e.g. position, or shape, or color ...).

Appropriate corrections are required.

Claim Rejections - 35 USC § 101

7.   Claim 66 discloses a non-statutory subject matter under 35 U.S.C. 101 because "a method for monitoring the display of content ..." is a computer-related method for performing

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a process.   This method does not perform independent

physical acts (it must rely on a execution/control of a

computer system/network) or manipulate data (which are not

disclosed) representing physical objects to achieve a

practical application; in contrast, it merely manipulates

abstract ideas without any limitation to a specific

practical application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate

paragraphs of 35 U.S.C. § 102 that form the basis for the

rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8.   Claims 1-2, 11-12, 15, 48-49, 57-58, 64, and 66 are

rejected under 35 U.S.C. § 102(b) as being anticipate by

Curran et al. (GB 2250112 - 5/27/92).

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Curran et al. disclose a system/method/computer-readable medium for monitoring displays by a computer system, comprising:

- instructions for causing the content to be displayed by a computer system (inherently in Curran et al.'s patent);

- means/step/instructions for monitoring a position/a change in time of an image on a display screen of a computer system (see Curran et al., pp. 4:9-12, 5:3-8, 17-23); and

- means/step/instructions for evaluating/comparing/judging a position/a change in time of an image on a display screen (see Curran et al., pp. 5:6-7 and 5:13-16).

Therefore, all of the limitations of those claims are met by Curran et al.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patent ability shall not be negatived by the manner in which the invention was made.

A. Claims 3, 9-10, 12, 31, 50, 56 are rejected under 35 U.S.C. §103(a) as being unpatentable over Curran et al. (GB

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2250112 - 5/27/92), in view of Brown (Using Netscape 2 -
Special Edition).

A1. As per claims 3/50, 9/56, 10/31: The rationales for
rejection of claims 2/49 are incorporated herein.

    Curran et al. don't discuss a means for determining if
a display is hidden by other images.

    However, Brown suggests that a means/instruction(s) for
comparing/ evaluating/determining if a display is hidden by
other images (see Brown, pp. 616-617, 639, 834-835, and 950-
951).

    - an image can be a pointer, & means for determine
times a pointer enter an area (claims 9/56 are obvious with
Brown's);

    - a content being monitored can be a graphical display
(claim 10/31 is obvious with Brown's);

    Therefore, it would have been obvious to one of
ordinary skill in the art at the time of invention to
implement Curran et al. 's system with Brown's suggestion
because it increases a completeness in monitoring a display
of content by a computer system.

B.   Claims 4-6, 17, 50-55, 63 are rejected under 35 U.S.C.
§103(a) as being unpatentable over Curran et al. (GB 2250112

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- 5/27/92), in view of Brown (Using Netscape 2 - Special
Edition),and further in view of Capps (US Pat. 5,634,100).

The rationales for rejection of claim 3 are
incorporated herein.

B1. Ref. To claims 4-6, 17, 51-53, 63: Curran et al. don't
discuss a means for determining a duration of each time if a
display is hidden by other images.

However, Brown obviously suggests there is a
means/instructions for determining a duration of each time
if a display is hidden by other images (see Brown, pp. 270,
805, 720-721). Furthermore, Capps clearly discloses that
fact with Figs. 7 & 10, 12:64-67. The limitation of
"...means for determining ...is not hidden .." is easily
figure out after solving the first limitation.

B2. Ref. To claims 7/54, 8/55:   The examiner submits that
claim 7/54 is a combination of claims 4-6. And claim 8/55
is a combination of claims 4-7; hence they are rejected with
similar rationales.

Therefore, it would have been obvious to one of
ordinary skill in the art at the time of invention to
implement Curran et al. 's system with Brown & Capps 's
suggestions because it increases a completeness in
monitoring a display of content by a computer system.

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C.   Claims 13/29/34/59/65, 61-62 are rejected under 35
U.S.C. §103(a) as being unpatentable over Curran et al. (GB
2250112 - 5/27/92), in view of Brown (Using Netscape 2 -
Special Edition),and further in view of Capps (US Pat.
5,634,100) & Lucero et al. (US Pat. 4,283,709).

Curran et al. discuss about monitoring displays on
computer system (using instructions for monitoring and
evaluating displays), wherein contents are inherently
displayed in response to instructions that is provided from
external sources. They failed to teach means for
ascertaining a beginning/an end of a display and a
relationship between them.

However, Lucero et al. ('709) obviously suggests these
missing features (see Lucero et al. 10:38-45, and 14:23-37).
Furthermore, Capps ('100)(suggests that fact with Figs. 8,
10, 18, and 12:64-67, 13:49-57, 16:56-64).

Ref. To claims 14/60:   The examiner submits that an
instruction is provided by a user of the system is obvious
in Curran et al. invention.

Ref. To claims 15-16, 32, 62, 64-65:   The examiner submits
that these claims are a combination of rejected claims 1 &
2; hence similar rationales are applied.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to implement Curran et al.'s system with Brown, Lucero et al. & Capps's suggestions because it increases a completeness in monitoring a display of content by a computer system.

10.   Claims 18-30, 32, 33, 35-41 are rejected under 35 U.S.C. §103(a) as being unpatentable over Curran et al. (GB 2250112 - 5/27/92), in view of Brown (Using Netscape 2 - Special Edition).

The rationales for rejection of claim 1 are incorporated herein.

Curran et al. do not clearly teach that "means for transferring data (means for monitoring) between sites in response to a signal (a transfer of data) from a provider site".

However, Brown (Using Netscape 2 - Special Edition) obviously suggests that feature, and features in claims 38-41.

Furthermore, the examiner submits that claim 23 is obvious in LAN/WAN for relaying messages; and it is inherent in Netscape to predict displays of many icons/fonts/shape (conclusions may be deduced regarding the observation of the content - claim 26);

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Claim 27/32 is a combination of claim 1 and 21; hence rationales for rejection is applied similarly;

Claim 28/33 is similar to claim 11; hence rationales for rejection is applied similarly;

It would have been obvious to one of ordinary skill in the art at the time of invention to implement Brown's suggestion in Curran et al. invention, because this is a well-known feature in data transfer area.

11. Claims 42-47 are rejected under 35 U.S.C. §103(a) as being unpatentable over Curran et al. (GB 2250112 - 5/27/92), in view of Brown (Using Netscape 2 - Special Edition), and further in view of Cannon et al. (US Pat. 5,673,382).

The rationales for rejection of claims 1, 18, 21, and 25 are incorporated herein.

Claim 42 is a combination of claim 1, 18, 21, and 25; hence rationales for rejection is applied similarly;

Claim 43 further having limitations which can be rejected based on Cannon et al. 's disclosure ('382 5:23-60);

It would have been obvious to one of ordinary skill in the art at the time of invention to implement Brown's suggestion, and Cannon et al. disclosure in Curran et al.

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invention, because these are well-known limitations in data

transfer area.

Conclusion

12.   Claims 1-66 are rejected.

13.   The related references (including the prior arts made

of record but not relied upon by the examiner) are

considered pertinent to applicant's disclosure.

14.   Any inquiry concerning this communication or earlier

communications from the examiner should be directed to

examiner Cuong H. Nguyen, whose telephone number is

(703)305-4553. The examiner can normally be reached on

Monday-Friday from 7:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are

unsuccessful, the examiner's supervisor, James P. Trammell,

can be reached on (703)305-9768.

Any response to this action should be mailed to:

Box Issue Fee   Amendments

Commissioner of Patents and Trademarks

c/o Technology Center 2700

Washington, D.C. 20231

or faxed to: (703) 308-9051, (for formal

communications intended for entry)

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Or: (703) 308-5397 (for informal or draft

communications, please label "PROPOSED" or

"DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the

status of this application should be directed to the Group

receptionist whose telephone number is (703)305-3900.

Cuong H. Nguyen
February 26, 1999

James P. Trammell
Supervisory Patent Examiner
Technology Center 2700

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Notice of References Cited		Application No. 08/707,279		Applicant(s) BLUMENAU			
		Examiner Cuong H. Nguyen		Group Art Unit 2764		Page 1 of 1	

U.S. PATENT DOCUMENTS

		DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS
*	A	5,799,292	8/25/98	Hekmatpour	707	513
*	B	5,673,382	9/30/97	Cannon et al.	395	182.04
	C	5,634,100	5/27/97	Capps	----	----
*	D	5,623,652	4/22/97	Vora et al.	707	10
*	E	5,414,809	5/09/95	Hogan et al.	346	349
	F	4,283,709	8/11/81	Lucero et al.	----	----
	G					
	H					
	I					
	J					
	K					
	L					
	M					

FOREIGN PATENT DOCUMENTS

		DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUBCLASS
	N						
	O						
	P						
	Q						
	R						
	S						
	T						

NON-PATENT DOCUMENTS

	DOCUMENT (including Author, Title, Source, and Pertinent Pages)	DATE
U	Brown, "Using Netscape 2- Special Edition", QUE, 2nd edition (attached pages).	1995
V		
W		
X		

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